UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,042	11/17/2000	Robert D. Briggs	PA000456	7621

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER
D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
2683	70

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04 February 2003</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *4-16, 20 and 29-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *4-16,20,29 and 30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claim 4-16, 20 and 29-30 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-16, 20 and 29-30 rejected under 35 U.S.C. 103(a) as being

unpatentable over Jansen further in view of Rieken US 6,009,154 and Ronen US

5,845,267 (hereafter Rieken and Ronen).

As per **claims 4 and 29**, Jansen teaches a method to invoice users (title is "pay-

per use") for information accessed using a communication network comprising:

Placing a first location in communication with a remote second location (figures 1

and 2 show the Kiosk being connected to a remote computer/building)

Transferring information having at least one associated cost from second to first

location, wherein transfer occurs prior to payment of the at least one associated cost

being made for the information (figure 10, #254 shows payment method can be PRE-

PAY, POST-PAY or FREE)

Debiting the first location for the selected information after the information is

transferred (figure 10, #300, 302, 304 and 306 calculating cost of the transfer and

submitting usage record to database and receipt being printed, also C10, L23-32,

specifically L28-32).

Recording associated costs at the first location and Communicating recorded costs from first location to an invoice location (figure 1 shows a Kiosk containing a computer processor, #14 which is further detailed in figure 4. Figure 2 shows a central server, #26 which is further detailed in figure 3. Both figures contain computers which are known in the art as being capable of recording/storing data on the processor and can communicate via comm. links shown in figure 1, #24/28. Figure 3 shows a database, #62 that contains billing records – these records can be recorded at either the Kiosk and/or at the central computer).

Communicating a debit charge from the second location to the invoicing location after the selected information is transferred (C3, L15-61, specifically L38 teaches a credit card reader to allow the user to be debited at the first location which is transferred through the central computer of figure 2 to a credit card company. One skilled in the art would provide for the debiting to be supported anywhere in the system).

Generating an invoice (figure 10, 300-306)

Communicating the invoice to a party responsible for satisfaction of the invoice (figure 10, #306 generates invoice/receipt for user at Kiosk)

But is silent on Comparing the recorded debits from the first location with the debits from the second location,

Rieken teaches flexible rate charging (figure 2) that involves negotiation between the user (eg. first location) and the service provider (eg. second location) for billing purposes. The examiner interprets this as reading on the claimed limitation of "comparing debits from first location with the debits from the second location". In essence, this can be viewed as an error-checking function and/or a way of gaining agreement from both users/ends (ie. on the price to be charged, on the amount of data downloaded, etc.).

With further regard to claim 8, Jansen teaches the ability to view, download and print many different types of information (C1, L45-63, specifically L62-63) **but is silent on** and the ability to charge independently of the amount of time used. Ronen teaches billing based on a transaction and not amount of time (abstract and Column 6,

Table 2 shows a bill with a $.50 charge to use the phone and $25 to download software).

With further regard to claims 14 and 25, Jansen teaches a computer/DSP system with storage (Kiosk in figure 1 and #14 is a computer with storage that executes code/instructions) communicating all costs from the first location to an invoicing location, generating an invoice and communicating the invoice to a party responsible for the satisfaction of the invoice (figure 4 shows a credit card reader and printer to print invoice/receipt, and figure 10 shows pay-for-use service #304 and print receipt #306 which is for the user) **but is silent on** and charging a debit to the first location each instance the copy is used at the first location, independently of the amount of time used. Ronen teaches billing based on a transaction and not amount of time (abstract and Column 6, Table 2 shows a bill with a $.50 charge to use the phone and $25 to download software). One skilled understands that the first location would be billed for each instance the copy is downloaded/used at the first location.

With further regard to claim 30, Jansen teaches a computer system (figure 1 Kiosk and network shown in figure 2) embodying machine-readable instructions (figure 1, #14 is a computer executing code/instructions).

It would have been obvious to one skilled in the art at the time of the invention to modify Jansen, such that checking/comparing is performed, to ensure that errors do not occur between the two end users/systems.

As per **claim 5,** Jansen teaches claim 4 further comprising a wireless communication device (C3, L35-38).

As per **claim 6,** Jansen teaches claim 5 further comprising connecting first and second locations via the Internet (figure 2, #40 shows connectivity to the Internet)

As per **claim 7,** Jansen teaches claim 6, further comprising at least one cost for information access and one for each-use (title is "pay-per use", abstract and C2, L13-42).

As per **claim 9**, Jansen teaches claim 1 further comprising:

Recording associated costs at the first location

Communicating recorded costs from first location to an invoice location (figure 1 shows a Kiosk containing a computer processor, #14 which is further detailed in figure 4. Figure 2 shows a central server, #26 which is further detailed in figure 3. Both figures contain computers which are known in the art as being capable of recording/storing data on the processor and can communicate via comm. links shown in figure 1, #24/28. Figure 3 shows a database, #62 that contains billing records – these records can be recorded at either the Kiosk and/or at the central computer).

As per **claim 10**, Jansen teaches claim 9 further comprising communicating a debit charge from the second location to the invoicing location after the selected information is transferred (C3, L15-61, specifically L38 teaches a credit card reader to allow the user to be debited at the first location which is transferred through the central computer of figure 2 to a credit card company. One skilled in the art would provide for the debiting to be supported anywhere in the system).

As per **claim 11**, Jansen teaches claim 10, further comprising a wireless communication device (C3, L35-38).

As per **claim 12**, Jansen teaches claim 11, further comprising connecting first and second locations via the Internet (figure 2, #40 shows connectivity to the Internet)

As per **claim 13**, Jansen teaches claim 12 wherein the selected information is an application program (abstract teaches receiving a "file" and C1, L62 teaches Internet access which can provide download of programs via FTP, etc.). The examiner interpets any downloading of generic files as reading on an application program download as well.

As per **claim 15**, Jansen teaches claim 14 wherein the another at least one associated cost is zero, wherein the copy of the designated information has an each-use associated cost, and wherein the each-use associated cost is incurred each time the designated information is used (abstract teaches "cost-per-unit-time" and a usage cost based on "time" and "information in file").

As per **claim 16**, Jansen teaches claim 15 wherein the copy of the designated information is used at the first location (figure 1 shows data downloaded to Kiosk).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
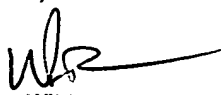
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMD
2-18-04

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600